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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,342	05/15/2006	Koji Seno	290783US2PCT	2151
22850	7590	10/02/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHU, CHRIS C	
			ART UNIT	PAPER NUMBER
			2815	
			NOTIFICATION DATE	DELIVERY MODE
			10/02/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/579,342	SENO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHRIS C. CHU	2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 45 - 66 is/are pending in the application.
- 4a) Of the above claim(s) 48 - 50 and 54 - 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45 - 47 and 51 - 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/15/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I (claims 45 – 47 and 51 - 53) in the reply filed on June 15, 2009 is acknowledged.

### ***Drawings***

2. Figures 45 – 52 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- (A) In Fig. 50, the reference number "b" is not disclosed in the specification of the instant invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any

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amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 45 – 47 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Kokubo et al. (U. S. Pub. No. 2002/0,061,401).

Regarding claim 45, Kokubo et al. discloses in e.g., Fig. 2 an anisotropically conductive sheet (10; page 7, paragraph 0141, lines 3 and 4) comprising:

- an insulating sheet body (12; page 8, paragraph 0141, line 14) formed of an elastic polymeric substance (page 8, paragraph 0145), in which a plurality of through holes (11; page 7, paragraph 0141, line 11) for forming conductive paths (see e.g., Fig. 2), each extending in a thickness-wise direction of the insulating sheet body (12; see e.g., Fig. 2), have been formed, and conductive path elements integrally provided in the

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- respective through-holes (11) for forming conductive paths of the insulating sheet body (12; see e.g., Fig. 2), wherein,
- the through-holes (11) for forming conductive paths in the insulating sheet body (12) are formed by using a mask for exposure, in which a plurality of through holes (11) for beam transmission, the diameter of each of which becomes gradually smaller from one surface toward the other surface of the mask, have been formed in accordance with a pattern corresponding to a pattern of conductive path elements to be formed (see e.g., Fig. 2), and irradiating the insulating sheet body (12) with a laser beam through the through-holes (11) for beam transmission in the mask for exposure from the other surface side of the mask for exposure (see e.g., Fig. 2).

Furthermore, the limitation “formed by using a mask for exposure, in which a plurality of through holes for beam transmission, the diameter of each of which becomes gradually smaller from one surface toward the other surface of the mask, have been formed in accordance with a pattern corresponding to a pattern of conductive path elements to be formed, and irradiating the insulating sheet body with a laser beam through the through-holes for beam transmission in the mask for exposure from the other surface side of the mask for exposure” is product-by-process limitation. Even though product-by-process claim is limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). A “product by process” claim is directed to the product per se, no matter how

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actually made, *In re Hirao*, **190 USPQ 15 at 17** (footnote 3). See also *In re Brown*, **173 USPQ 685**; *In re Luck*, **177 USPQ 523**; *In re Fessmann*, **180 USPQ 324**; *In re Avery*, **186 USPQ 116**; *In re Wertheim*, **191 USPQ 90 (209 USPQ 254** does not deal with this issue); and *In re Marosi et al.*, **218 USPQ 289** final product per se which must be determined in a “product by, all of” claim, and not the patentability of the process, and that an old or obvious product, whether claimed in “product by process” claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

Regarding claim 46, Kokubo et al. discloses in e.g., Fig. 2 the conductive path elements (the conductive element in the opening 11) containing conductive particles (P; page 9, paragraph 0159, line 1) exhibiting magnetism in a state oriented in a thickness-wise direction thereof (see e.g., Fig. 2).

Regarding claim 47, Kokubo et al. discloses in e.g., Fig. 2 the elastic polymeric substance forming the insulating sheet body (12) being silicone rubber (page 8, paragraph 0145, lines 1 – 4).

Regarding claim 51, Kokubo et al. discloses in e.g., Fig. 22 an anisotropically conductive connector (15; page 13, paragraph 0228, lines 1 – 5) comprising a frame plate (16; page 13, paragraph 0228, line 4) having an opening (the opening in the element 16 that contains the element 10) and the anisotropically conductive sheet (10) according to claim 45, which is arranged so as to close the opening (the opening in the element 16 that contains the element 10) in the frame plate (16) and supported by an opening edge of the frame plate (16; see e.g., Fig. 22).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokubo et al.

Regarding claim 52, Kokubo et al. discloses in e.g., Fig. 22 an anisotropically conductive connector (15) suitable for use in conducting electrical inspection of each of a plurality of integrated circuits (76, i.e., the ICs on the wafer; page 13, paragraph 0230, lines 1 – 6) formed on a wafer (the wafer) in a state of the wafer, comprising: a frame plate (16), in which a opening (the opening in the element 16 that contains the element 10) have been formed correspondingly to regions, in which electrodes to be inspected in all of the integrated circuits formed on the wafer, which is an object of inspection, have been arranged, and an anisotropically conductive sheet respectively arranged so as to close the openings in the frame plate (16) and supported by their corresponding opening edges of the frame plate (16), wherein each of the anisotropically conductive sheets (10) is the anisotropically conductive sheet according to claim 45. Kokubo et al. do not disclose a plurality of openings within the frame plate and a plurality of anisotropically conductive sheets respectively arranged so as to close the openings in the frame plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the opening within the frame plate and an anisotropically conductive sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine

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skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 52, Kokubo et al. discloses in e.g., Fig. 22 an anisotropically conductive connector (15) suitable for use in conducting electrical inspection of each of a plurality of integrated circuits (76, i.e., the ICs on the wafer; page 13, paragraph 0230, lines 1 – 6) formed on a wafer (the wafer) in a state of the wafer, comprising: a frame plate (16), in which a opening (the opening in the element 16 that contains the element 10) have been formed correspondingly to regions, in which electrodes to be inspected in all of the integrated circuits formed on the wafer, which is an object of inspection, have been arranged, and an anisotropically conductive sheet respectively arranged so as to close the openings in the frame plate (16) and supported by their corresponding opening edges of the frame plate (16), wherein each of the anisotropically conductive sheets (10) is the anisotropically conductive sheet according to claim 45. Kokubo et al. do not disclose a plurality of openings within the frame plate and a plurality of anisotropically conductive sheets respectively arranged so as to close the openings in the frame plate, and selecting some integrated circuits from among the integrated circuits formed on the wafer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the opening within the frame plate and an anisotropically conductive sheet and selecting some integrated circuits from among the integrated circuits formed on the wafer, since it has been held that mere duplication and selection of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's



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disclosure. Hashitani et al., Namba, Inoue et al., Kokubo et al., Yamada et al. '280, Sato et al., Yamada et al. '722, Kobayashi et al., Kimura, Strid et al., Higashi et al., Fujimori et al., Yoshizawa et al., Ju, and Haruta et al. disclose an anisotropically conductive sheet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS C. CHU whose telephone number is (571)272-1724. The examiner can normally be reached on 11:30 - 8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Friday, September 25, 2009